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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROAKI SHINOHARA

Appeal 2007-4428
Application 09/898,422
Technology Center 2600

Decided: June 2, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and
KARL D. EASTHOM, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3, 5, 6, 12, 13, 15, and 17-19, which are all of the claims pending in this application as claims 2, 4, 7-11, 14, 16, and 20-27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant invented a system for returning recommendations related to a recorded program including a TV and a processor which may be incorporated in a personal video recorder (PVR) coupled to the TV. The processor receives media-stored content and accesses a database to return recommendations or to record a broadcast program based on the viewer selections of the content (Spec. 2). For example, after the viewer selects the name of an actor in a DVD-played movie, the processor records or recommends other broadcast programs in which the actor appears (Spec. 2-3).

Independent Claims 1 and 12 are representative and read as follows:

1. A system for returning recommendations related to a recorded program, comprising:

a DVD player for playing a disk containing media-stored content including text;

a TV communicating with the DVD player; and

a personal video recorder (PVR) including a processor coupled to the TV and receiving the media-stored content, the processor accessing at least one database to return recommendations based at least partially on a viewer-selected portion of the text or to record at least one broadcast program based at least partially on a viewer-selected portion of the text.

12. A system for linking content to viewing and/or shopping recommendations, comprising:

means for selecting alpha numeric characters that are part of a DVD content;

means for receiving the alpha numeric characters; and

means responsive to the means for selecting for automatically accessing a source of recommended viewing and/or shopping.

The Examiner relies on the following prior art references:

Mankovitz	US 5,541,738	Jul. 30, 1996
Killian	US 6,163,316	Dec. 19, 2000

The rejections, as presented by the Examiner, are as follows:

Claims 12, 13, 15, and 17-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Killian.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankovitz in view of the Official Notice taken by the Examiner.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankovitz in view of the Official Notice taken by the Examiner and further in view of Killian.

Rather than repeat the arguments here, we make reference to the Briefs¹ and the Answer² for the respective positions of Appellant and the Examiner.

We affirm-in-part.

ISSUES

1. Under 35 U.S.C § 102(b), with respect to the appealed claims 12, 13, 15, and 17-19, does Killian anticipate the claimed subject matter by teaching all of the claimed limitations?

¹ Appellant filed an Appeal Brief on Apr. 10, 2006 and a Reply Brief on Jul. 3, 2006.

² The Examiner's Answer was mailed on July 20, 2007.

2. Under 35 U.S.C § 103(a), with respect to the appealed claims 1, 3, 5, and 6, would the ordinarily skilled artisan have found it obvious to modify Mankovitz based on the Examiner Official Notice or together based on the Official Notice and Killian to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. *Anticipation*

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

2. *Obviousness*

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

3. *Burdens of Proof and Production*

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of

obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Only if that burden is met, does the burden of going forward shift to the applicant. *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970).

Once a prima facie case is established and rebuttal evidence is submitted, the ultimate question becomes whether, based on the totality of the record, the examiner carried his burden of proof by preponderance. *See In re Oetiker*, 977 F.2d at 1445. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d at 1074.

ANALYSIS

1. 35 U.S.C. § 102 Rejection

Appellant contends that Killian downloads a JAVA-based electronic program guide (EPG) 70 from the Internet and provides no such guide based on a DVD or the alphanumeric content on a DVD (App. Br. 7). In response, the Examiner points to the disclosure in Killian in column 7, ll. 33-48 and the portion expanding from column 10, l. 61 to column 11, l. 21 and concludes that the viewing or shopping recommendations are “based on viewer’s selection of characters data that are part of a DVD content” (Ans. 9).

Killian provides for a program guide that is either downloaded from the Internet or installed locally (col. 8, ll. 36-40). Although the guide includes alphanumeric characters, the Examiner has not shown how these characters are part of a DVD content. We agree with Appellant (Reply Br. 3) that Killian, in the cited portions, provides suggestions regarding

programming to a user based on the programming information and user profile. Killian does not mention a DVD or its content as the source of the programming information used for viewing and/or shopping recommendation.

In view of the analysis above, we find that the Examiner has not shown that Killian *prima facie* anticipates claim 12 as the reference fails to teach all the recited features. We therefore, do not sustain the 35 U.S.C. § 102(e) rejection of claim 12, as well as claims 13, 15, and 17-19 dependent thereon, as being anticipated by Killian.

2. 35 U.S.C. § 103 Rejections

With respect to claims 1 and 3, Appellant contends that the VCR in Mankovitz is used to record a broadcast EPG to be used for selecting future programming for recording (App. Br. 4). The Examiner argues that a user selects preferences from the display of an EPG which, in turn, displays text (Ans. 7). The Examiner further asserts that although Mankovitz uses a VCR for recording the desired programs (*id.*), a DVD could be used and takes Official Notice for replacing the VCR by a DVD player as it is a known recorder (Ans. 8). Appellant responds by asserting that while a DVD is well known, claim 1 not only requires playing content from a DVD, but also requires allowing a user to select text from the DVD content and returning a viewing recommendation or scheduling a recording based on the selection (Reply Br. 2).

We disagree with Appellant that Mankovitz does not indicate that the user selects text from the played program from a recorded content including text. While the program guide of Mankovitz may be available to the user as

a broadcast program, it is also available as a prerecorded guide on a tape to be purchased (col. 1, ll. 52-57). Such prerecorded program guide is a media-stored content which includes text. Mankovitz teaches that the user selects programs to be recorded from the program guide text either by selecting and entering the information related to the “PULSECODE™” of that program (col. 10, ll. 45-51) or simply selecting the guide information displayed (col. 12, ll. 32-38), or starting recording if the selected program is being broadcast (col. 12, ll. 47-50).

We also disagree with Appellant’s argument that since Mankovitz uses a broadcast EPG, replacing a broadcast recorder with a read-only DVD would not work (App. Br. 5). The rejected claim calls for using a DVD player for playing a disk containing content including text, which is what the recorded EPG is played on. The broadcast program to be recorded will still be recorded by the VCR in Mankovitz, which is consistent with the claim requirements of recording at least one broadcast program by a personal video recorder.

With respect to the rejection of claims 5 and 6, Appellant argues that the rejection takes the claimed “database” to be the broadcast station itself as Figure 1 of Killian shows the database content is received from a conventional broadcast source, as opposed to the Internet (App. Br. 7). We agree with the Examiner that the Internet shown in Figure 1 to be linked to platform 12 via link 14 is actually connected to program listing database 48 through server 46, which contains television programming information (col. 3, ll. 43-50).

Under the facts we have here and the arguments presented by the Examiner and Appellant, as described above, we have concluded that

Appellant has not shown any error in the Examiner's position for finding claims 1, 3, 5, and 6 unpatentable for obviousness under 35 U.S.C. § 103(a).

CONCLUSION

On the record before us, we find that the Examiner fails to make a prima facie case that Killian anticipates claims 12, 13, 15, and 17-19, we do not sustain the 35 U.S.C. § 102 rejection of these claims. However, in view of our discussion above, we sustain the 35 U.S.C. § 103(a) rejection of claims 1 and 3 over Mankovitz in view of the Examiner's taking of Official Notice and of claims 5 and 6 over Mankovitz, the Examiner's taking of Official Notice, and in view of Killian.

ORDER

The decision of the Examiner rejecting claims 1, 3, 5, 6, 12, 13, 15, and 17-19 is affirmed-in-part.

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AFFIRMED-IN-PART

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